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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/762,243 | 02/05/2001 | Yoram Kapulnik | 01/21632 | 2822 |

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02/18/2004

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EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|--------------------------------------|--|--|
| Advisory Action | Application No. 09/762,243 | Applicant(s) KAPULNIK ET AL. | |
| | Examiner Anne R. Kubelik | Art Unit 1638 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 112, 1st enablement; 112, 2nd.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 54-60.

Claim(s) withdrawn from consideration: _____

8. ☒ The drawing correction filed on 06 January 2004 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE:

New matter: Neither the instant specification nor the originally filed claims appear to provide support for the phrase "wherein said viable plants are male fertile" in claim 56.

Neither the instant specification nor the originally filed claims provide support for the phrase "vegetative tissue" in claim 55. Applicant urges that pg 25, lines 10-14 of the published PCT defines somatic and vegetative tissue and the Examples illustrate selective degeneration of vegetative tissue. This is not found persuasive. The specification states that the invention is drawn to a method of effecting degeneration of somatic plant tissue (pg 2, lines 12-13), and "somatic" is defined as referring to both vegetative and reproductive plant tissues, not either vegetative or reproductive plant tissues (pg 25, lines 10-13). Thus, the invention as originally filed is not drawn to use only in vegetative tissue.

Continuation of 5. does NOT place the application in condition for allowance because:
112, 1st, new matter: See above.

102 over each of Howard et al, Baszczynski et al, and Albertson et al: Applicant urges that the instant invention is drawn to method for controlling plant morphology via selective somatic plant tissue degeneration. Applicant urges that the prior art methods do not employ or suggest a step of identifying and selecting plants that exhibit altered morphology as a result of somatic degeneration and that the claims have been amended to recite that the selected plants exhibit degeneration of the selected tissue. Applicant urges that the selection step is pivotal as expression of streptavidin does not produce progeny with uniform morphology and may lead to plant death. This is not found persuasive. Male sterility is a morphological characteristic that can be observed "see Albertson et al, column 19, lines 63-67) and plants were selected (ibid). See also Howard et al, pg 26, lines 8-12. Selection of male sterile plants would be inherent to Baszczynski.

103 over Baszczynski et al in view of each of Mariani et al and Maliga et al. Applicant urges that Mariani et al and Maliga et al describe degeneration of somatic tissue using an enzyme that is toxic to plant cells and that the methods are directed at generating plants that are male sterile. Applicant urges that none of the references describe or suggest selection of plants exhibiting somatic tissue degeneration. This is not found persuasive. Applicant admits that Mariani et al and Maliga et al describe degeneration of somatic tissue; plants exhibiting somatic tissue degeneration must inherently be selected to produce male sterile plants. The purpose of the method of Baszczynski et al in view of each of Mariani et al and Maliga et al is not relevant given that somatic tissue is degenerated and that plants with the desired characteristics must be selected.

Continuation of 10. Other: The petition filed under 37 CFR 1.84(a)(2) requesting acceptance of color drawings is not accepted because it fails to explain why the color drawings are necessary. See MPEP 608.01(f) and 37 CFR 1.84

A handwritten signature in black ink, appearing to read "A. J. Smith", is located in the lower right quadrant of the page.